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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,088	05/01/2001	Y. Tom Tang	PF-0622 USN	8378

7590

10/20/2003

Incyte Genomics Inc  
Legal Department  
3160 Porter Drive  
Palo Alto, CA 94304

EXAMINER
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HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/20/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/831,088

Applicant(s)

TANG ET AL.

Examiner

Richard G Hutson

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-26 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) 32-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-26 is/are allowed.
- 6) ☒ Claim(s) 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicants amendment canceling claims 21-23, 27-30 and 35-36, Paper No. 16, 6/23/2003, is acknowledged. Claims 24-26, 31-34 are at issue and are present for examination.

Applicants remarks at the top of page 4 of Paper No. 16, stating that the Office Action of April 21, 2003 that claims 24-36 and 31 contain allowable subject matter is acknowledged however this statement contains a mistake, as claims 24-**26** and 31 were said to contain allowable subject matter, not claims 24-**36** and 31.

Applicants request for reconsideration by the Examiner for the withdrawal of the *Ex parte Quayle* action and for rejoinder of method claims 32-34 and the filing of a petition under 37 C.F.R. 1.181(a) supporting applicants request with respect to each of these issues, is acknowledged. The petition is being treated as a request for reconsideration.

Applicants request for the withdrawal of the *Ex parte Quayle* action, April 21, 2003, is considered moot and applicants request for the rejoinder of claims 32-34 is considered untimely and held in abeyance, in view of the following non-final office action in which prosecution is hereby reopened.

### ***Election/Restrictions***

Applicant's previous election with traverse of Group II, Claims 23-26, 28, 30 and 31 in Paper No. 13 is acknowledged. Applicant's further election with traverse of SEQ ID NO: 9I, Claims 24-26, 28 and 31 in Paper No. 13 is acknowledged. Applicants

traversed the restriction requirement on several grounds and applicants traversal was dealt with in the previous office action.

Applicants comments with respect to the rejoinder of claims 32-34 are also acknowledged, however as discussed previously, the methods of claims 32-34 are not subject to rejoinder as they do not recite methods of using the allowable product but instead methods of using fragments of the allowable product.

The requirement is still deemed proper and is therefore made FINAL.

Claims 32-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 13.

#### ***Information Disclosure Statement***

Applicants filing of information disclosures, Paper No. 14, filed 2/6/2003, is acknowledged. Those references considered have been initialed.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 is indefinite in that it is vague and confusing in the recitation "a polynucleotide complementary to the polynucleotide of a)" because it is unclear if it applicants intent to include polynucleotides that are merely partially complementary to the polynucleotide of a) as being encompassed by this recitation. In applicants specification, in a section entitled "Definitions" at page 7, line 25-27, applicants state "Complementarity between two single-stranded molecules may be "partial," such that only some of the nucleic acids bind, or it may be "complete," such that total complementarity exists between the single stranded molecules. Thus it is unclear if applicants intend to include both those polynucleotides which are have merely partial complementarity as well as those polynucleotides which have "complete" complementarity to the polynucleotide of a). For the purpose of advancing prosecution, the claim is interpreted as encompassing those polynucleotides having only partial as well as complete complementarity to the polynucleotide of a). An amendment of this recitation to "a polynucleotide completely complementary to the polynucleotide of a)" along with comment supporting would help applicants overcome this rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.


Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Minekura et al. (Genomics, Vol.42, pp 180-181, 1997, See IDS).

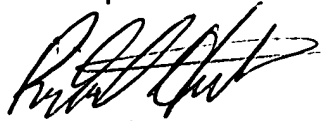
Minekura et al. teach the identification and isolation of a nearly full length cDNA for human ACS3 which has a best local similarity score of greater than 99% identity to instantly disclosed SEQ ID NO: 9 between position 272 and position 3164. Minekura et al. further teach a number of different human ACS3-specific primers that were used for the detection of the human ACS3 gene. The cDNA as well as the primers taught by Minekura et al. each anticipate claim 31 which is drawn to an isolated polynucleotide complementary to a polynucleotide comprising the polynucleotide sequence of SEQ ID NO: 9 (See also above 112 second paragraph rejection).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
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